

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE ENDEL DECKNER,
BRIAN FRANCIS GRAY,
RYO MINOGUCHI,
KAORU NIIHARA,
ROBERT RAYMOND SCHMIDT, and
RAPHAEL WARREN

Appeal 2006-2741
Application 10/009,083
Technology Center 1600

Decided: March 30, 2007

Before CHARLES F. WARREN, THOMAS A. WALTZ, and
PETER F. KRATZ, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Primary Examiner's final rejection of claims 1-36, which are the only claims pending in this

application (Br. 2). We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

According to Appellants, the invention is directed to an absorbent article, such as a sanitary napkin, having a body contacting surface and an absorbent core, where at least a portion of the body contacting surface contains an effective amount of a skin care composition which is solid or semisolid at 40°C and is transferable to the wearer's skin through contact or movement (Br. 2). Independent claim 1 is representative of the invention and is reproduced below:

1. An absorbent article comprising a body contacting surface and an absorbent core, wherein
 - (1) at least a portion of the body contacting surface comprises an effective amount of a skin care composition which is solid or semisolid at 40°C and which is transferable from the body contacting surface to the wearer's skin by contact, normal wearer motion and body heat at a level effective in providing a skin benefit to the wearer's skin, and
 - (2) the skin care composition has viscosity of more than about 10^5 Poise under shear stress of less than about 3×10^4 dynes/cm², and viscosity of less than about 10^2 Poise under shear stress of more than about 10^6 dynes/cm², at 40°C.

The Examiner has relied on the following references as evidence of anticipation or obviousness:

| | | |
|---------------|-----------------|---------------|
| Osborn | WO 98/55158 | Dec. 10, 1998 |
| Van Rijswijck | WO 99/12530 | Mar. 18, 1999 |
| Roe | WO 99/22684 | May 14, 1999 |
| Gatto | US 6,570,054 B1 | May 27, 2003 |

ISSUES ON APPEAL

Claims 1-36 stand rejected under 35 U.S.C. § 102(e) as anticipated by Gatto (Answer 4).

Claims 1-36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Osborn, Van Rijswijck, and Roe (Answer 6).

Appellants contend that Gatto discloses the lotion composition being in a melt state at 40°C, and therefore Gatto does not disclose with sufficient precision and detail the lotion being solid or semisolid at 40°C as required by the claims on appeal (Br. 4, 6).

Appellants contend that the Examiner has failed to indicate where in Gatto is found the claim requirement regarding the viscosity under shear stress for the lotion composition (Br. 6).

Appellants contend that the Examiner has not shown where in any of the references to Osborn, Van Rijswijck, and Roe are found all of the elements of claims 1 and 30 (Br. 11).

Appellants contend that the Examiner has only made a conclusory statement and failed to state why one of ordinary skill in the art would have combined the three separate references (Br. 11-12).

The Examiner contends that Gatto discloses lotion compositions that include a range of melting points, including melting points that render the lotion composition solid or semisolid at 40°C (Answer 9-10).

The Examiner cites the relevant portions of Osborn, Van Rijswijck, and Roe that relate to the claimed limitations (Answer 6-7), and contends that sufficient motivation has been established since all the references are directed to similar skin care compositions on similar absorbent articles (Answer 12).

Accordingly, the issues in this appeal are as follows: (1) does Gatto disclose or teach a lotion composition that is solid or semisolid at 40°C with sufficient precision and detail to anticipate the claimed lotion composition; (2) does Gatto disclose or teach the claim requirement of viscosity as a function of shear stress; (3) do Osborn, Van Rijswijck, and Roe disclose or suggest all of the limitations found in claims 1 and 30; and (4) is there sufficient motivation, reason, or suggestion on this record to combine Osborn, Van Rijswijck, and Roe as proposed by the Examiner?

We determine that the Examiner has established a prima facie case of anticipation and obviousness in view of the reference evidence. We determine that this prima facie case has not been adequately rebutted by Appellants' arguments. Therefore we AFFIRM all grounds of rejection in this appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

A. The Rejection under § 102(e)

We determine the following factual findings from the record in this appeal:

- (1) Gatto discloses an absorbent article having a stable skin care composition disposed on its skin-contacting surface, where the composition is readily transferable to the wearer's skin by normal contact, wearer motion, or body heat (Abstract; col. 5, ll. 1-8);
- (2) Gatto discloses that suitable skin care compositions have an elastic modulus of at least 5 dynes/cm², measured at a strain rate of 0.2%, an oscillation frequency of 10 rad/sec and a temperature of 77°C (col. 5, ll. 12-26), an apparent viscosity of about 1 to about

100,000 centipoise (col. 8, ll. 26-28 and 53-55), and a zero shear viscosity at room temperature between about 1.0×10^6 centipoise and 1.0×10^8 centipoise (col. 9, ll. 13-17);¹

- (3) Gatto teaches that the skin care compositions comprise a carrier, an emollient, a skin care ingredient, at least one rheological agent, and an immobilizing agent (col. 7, ll. 29-33), where the compositions preferably have a final melting point above potential “stressful” storage conditions, i.e., greater than 45°C (col. 9, ll. 27-43);
- (4) Gatto teaches that to enhance the immobility of the preferred skin care compositions, the viscosity should be as high as necessary to prevent substantial flow within the article to undesired locations while not too high a viscosity to inhibit transfer of the composition to the skin, i.e., a balance should be achieved to accomplish each of these objectives (col. 9, ll. 19-27); and
- (5) Gatto specifically exemplifies the same skin care components in about the same amounts as recited in the claims on appeal and disclosed in Appellants’ Specification 52 *et seq.* (see Tables 1-6 in cols. 37-39), and also presents examples where the skin care compositions are solid or semi-solid at 40°C with an elastic modulus of greater than 5,000,000 dynes per square centimeter at this temperature (Table 7, col. 40).

Merely choosing to describe an otherwise known product in terms of certain physical characteristics not recited in the prior art does not render the

¹ Gatto describes the test methods for determining each one of these properties (col. 36, ll. 30-64).

product patentable. *See In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975). Where the Examiner has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, the burden of proof shifts to the applicant to prove that the subject matter shown in the prior art does not possess the characteristic relied on. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Applying the preceding legal principles to the factual findings in the record of this appeal, we determine that the Examiner has established a prima facie case of anticipation which Appellants have not adequately rebutted by evidence, arguments, or technical reasoning. Appellants only contend that Gatto fails to disclose or teach that the skin care composition is “solid or semisolid at 40°C” and the viscosity vs. shear stress values recited in claim 1 on appeal (Br. 4-6). As shown by factual findings (3) and (5) listed above, Gatto clearly describes skin care compositions that are solid or semisolid at 40°C.² As also shown by factual findings (2), (4), and (5) listed above, Gatto characterizes the physical state of the skin care compositions by many variables, especially viscosity, teaching the balance of viscosity needed for a suitable product, and teaches the same specific skin care components in about the same amounts as claimed and disclosed by Appellants. Therefore we determine that it reasonably appears that the products of Gatto are the same or substantially the same as the claimed

² We determine that a teaching in Gatto that the skin care composition should have a melting point above 45°C clearly describes a skin care composition that is solid, or at least semisolid, at 40°C.

product. Accordingly, the burden of proof has been shifted to Appellants, and Appellants have not offered any evidence or reasoning to meet their burden. *See In re Spada, supra; In re Best, supra.*

For the foregoing reasons and those stated in the Answer, we affirm the rejection of claims 1-36 under § 102(e) over Gatto.

B. The Rejection based on § 103(a)

We determine the following factual findings from the record in this appeal:

- (1) Osborn, Van Rijswijck, and Roe all disclose absorbent articles with at least one skin care composition on at least a portion of a body-contacting surface (Abstract of each reference);
- (2) Osborn teaches that the emollient composition preferably melts at a temperature from about 40 to 90°C (p. 38, 2nd full paragraph) while both Van Rijswijck and Roe teach that the skin care compositions have a “melting profile” such that they are relatively immobile and localized on the wearer-contacting surface at room temperature (20°C), are readily transferable to the wearer at body temperature (37°C), and yet are not completely liquid under extreme storage conditions (45°C) (Van Rijswijck 9-10; Roe 40-41);
- (3) Both Van Rijswijck and Roe teach that the final melting point of the skin care composition should be above 45°C, i.e., the composition will be a solid or at least a semisolid at 40°C (*id.*);

- (4) Both Van Rijswijck and Roe teach that a balance should be achieved for the viscosity of the skin care composition, i.e., the viscosity should be high enough to keep the compositions localized on the surface of the article, but not so high as to impede transfer to the wearer's skin (Van Rijswijck 10-11; Roe 41); and
- (5) All three references exemplify skin care compositions having components the same or similar in nature and amount to those claimed and disclosed by Appellants (Osborn 51 *et seq.*; Van Rijswijck 51 *et seq.*; and Roe 59 *et seq.*; compare the Specification 52 *et seq.*).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). When it is necessary to select elements of various teachings of the prior art in order to form the claimed invention, we must determine whether there is any suggestion or motivation in the prior art to make the selection made by Appellants. *See In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Applying the preceding legal principles to the factual findings on the record in this appeal, we determine that the Examiner has established a *prima facie* case of obviousness which has not been adequately rebutted by Appellants' arguments. We determine that each reference *alone* discloses or suggests every limitation of claim 1 on appeal, namely an absorbent article with a body contacting surface and an absorbent core, with a skin care composition on at least a portion of the body-contacting surface, which

composition is a solid or semisolid at 40°C and has a viscosity suitable for its function (see above factual findings (1) through (4) at pp. 7-8).

Additionally, we determine that each reference discloses similar examples of components and amounts in the skin care compositions as compared to those claimed and disclosed by Appellants (see above factual finding (5) at p. 8).

Therefore, we determine that it reasonably appears that the product of each reference is the same or substantially the same as the claimed product. *See In re Spada, supra; In re Best, supra.* We note that no motivation for the combination of references need be shown if each reference alone discloses or suggests the claimed product. However, we determine that the Examiner has established an adequate motivation or suggestion for combining the references, namely that all of the references are directed to very similar absorbent articles containing at least one very similar skin care composition (Answer 12). Accordingly, one of ordinary skill in this art would have recognized the relative equivalency of the various components in the skin care compositions of the three references, and the use of any combination of emollients and immobilizing agents meeting the required melting point profiles and viscosity balance would have been obvious. *See In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982) (“Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious. [Citation omitted].”).

For the foregoing reasons and those stated in the Answer, we determine that the Examiner has established a prima facie case of obviousness based on the reference evidence. Based on the totality of the record, including due consideration of Appellants’ arguments, we determine that the preponderance of evidence weighs most heavily in favor of

obviousness within the meaning of § 103(a). Therefore we affirm the rejection of claims 1-36 under § 103(a) over Osborn, Van Rijswijck, and Roe.

C. Time Period

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

tf/lr

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